

### REMARKS

Reconsideration of the above-identified application is respectfully requested. Claims 1-12 have been amended; Claims 13, 25, and 27 have been canceled; and new Claims 37-40 have been added. Therefore, Claims 1-12, 14-24, 26, and 28-40 are pending in the present application.

Claims 1-24, 26, and 28-36 were provisionally rejected in an Office Action dated September 2, 2003 (hereinafter "Office Action") under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-16 of copending Application No. 09/757,827, to Aiken, in view of U.S. Patent No. 5,704,139, to Okajima (hereinafter "Okajima"). Claims 1, 2, 5, 7, 8, 14-17, and 21 were further rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 1,097,875, issued to Pierce (hereinafter "Pierce"). Applicants believe that the present application is in condition for allowance for the reasons discussed in detail below.

#### Obviousness-Type Double Patenting

Claims 1-24, 26, and 28-36 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-16 of co-pending Application No. 09/757,827, to Aiken, in view of Okajima. Applicants note the provisional rejection. Applicants have submitted herewith a terminal disclaimer executed by Jerald E. Nagae, a registered attorney of record. Accordingly, applicants request withdrawal of the pending obviousness-type double patenting rejections.

#### Claim Rejections Under 35 U.S.C. § 102

Claims 1, 2, 5, 7, 8, 14-17, and 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Pierce. Applicants respectfully traverse the rejections of these claims. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or

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inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d. 1051, 1053 (Fed. Cir. 1987). For at least the following reasons, applicants respectfully assert that the claimed combination of features recited in Claims 1, 2, 5, 7, 8, 14-17, and 21 are neither taught nor suggested by Pierce.

#### Independent Claim 1

Claim 1 has been amended to recite an outsole of an athletic boot comprising an outsole body having a toe region and a heel region, a frame member secured to the outsole body, and a pair of adjustment members adjustably mounted on the frame member at either the toe region or the heel region of the outsole body. A portion of each adjustment member is adapted for engagement with a binding and is extendable in a selected amount away from the frame member.

In contrast to Claim 1, Pierce purportedly teaches an ice skate having an upper and a sole to which heel and toe plates 2 and 3 are secured. A skate blade 1 is attached to the heel and toe plates 2 and 3 through individual toe and heel coupling assemblies. Each coupling assembly includes a lug 4 secured to the heel and toe plates 2 and 3, a threaded bolt 6 having a head portion 5 pivotally coupled to the lugs 4, and an internally threaded socket 7 secured to the blade 1 for threadably engaging the thread end of the bolt 6. As such, by screwing the bolt 6 to a greater or lesser distance into the socket 7, the tilt of the skate blade 1 may be adjusted. Please see FIGURE 1. Since Pierce teaches only one heel coupling assembly and only one toe coupling assembly, applicants respectfully assert that Pierce fails to teach or suggest "a pair of adjustment members adjustably mounted on said frame member at either said toe region or said heel region of said outsole body."

It is clear from the foregoing that Pierce fails to teach the recited combination of features of amended Claim 1. Thus, applicants respectfully request withdrawal of the pending rejections under 35 U.S.C. § 102(b) with regard to Claim 1. Accordingly, applicants respectfully request

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withdrawal of the pending rejections under Section 102(b) of Claims 2, 5, 7, and 8, which depend from allowable Claim 1.

#### Independent Claim 14

Claim 14 recites an athletic boot selectively mountable to a binding. The athletic boot comprises an upper fixedly secured to an outsole, an interface adjustment mechanism for adjusting the interface between the boot and the binding, and at least one binding attachment member coupled to the outsole. As was discussed above, Pierce is directed to an ice skate. Accordingly, applicants respectfully assert that Pierce fails to teach or suggest any structure coupled to the outsole of the skate that may be characterized as a binding attachment member.

It is clear from the foregoing that Pierce fails to teach the recited combination of features of Claim 14. Thus, applicants respectfully request withdrawal of the pending rejection under 35 U.S.C. § 102(b) with regard to Claim 14. Accordingly, applicants respectfully request withdrawal of the pending rejections under 35 U.S.C. § 102(b) of Claims 15-17, and 21, which depend from allowable Claim 14.

#### New Claims 37-40

Previously pending Claims 3, 4, 6, and 9 have been rewritten in independent form as new Claims 37-40, respectively. Previously pending Claims 3, 4, 6, and 9 were rejected in the Office Action under obviousness-type double patenting as being unpatentable over Claims 1-16 of co-pending Application No. 09/757,827, to Aiken in view of Okajima. Based on the submitted terminal disclaimer, applicants submit that new Claims 37-40 are in condition for allowance.

#### CONCLUSION

In light of the foregoing amendments and remarks, applicants assert that the claims of the present application recite combinations of features neither suggested nor taught by the prior art. Therefore, applicants respectfully request early and favorable action, and the allowance of all

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pending claims. If any further questions remain, the Examiner is invited to telephone applicants' attorney at the number listed below.

Respectfully submitted,

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